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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/936,304	09/24/1997	DAWEI DONG	15758.705	9608
7590 08/24/2005				
ADAN AYALA, ESQ. BLACK & DECKER INC. 701 E. JOPPA ROAD, TW-199 TOWSON, MD 21286			EXAMINER RODRIGUEZ, ARMANDO	
			ART UNIT 2828	PAPER NUMBER

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/936,304

Applicant(s)

DONG, DAWEI

Examiner

ARMANDO RODRIGUEZ

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6 and 10-14 is/are rejected.
- 7) ☒ Claim(s) 7-9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Claims 6-14 are pending.

Claims 1-5 have been canceled.

Response to Arguments

Applicant's arguments filed June 8, 2005 have been fully considered but they are not persuasive.

Regarding applicant's argument on page 5 pertaining to the cited prior art reference to Imbrie (5,400,514), where applicant discusses that the reference should not be applied as a 35 USC 102 (b) because the present application has a filing date of April 3, 1995 based on continuation-in-part of application 08/415,960, which has been abandoned. In accordance with MPEP 201.08, a continuation-in-part is an application filed during the lifetime of an earlier nonprovisional application, repeating some substantial portion or all of the earlier nonprovisional application and adding matter not disclosed in the said earlier nonprovisional application. (In re Klein, 1930 C.D. 2, 393 O.G. 519 (Comm'r Pat. 1930)), as such applicant has not stated what part of the present application is disclosed in application 08/415,960 in order to obtain benefit of the earlier filing date.

Regarding applicant's arguments on page 5 pertaining to amended claim 6, 11 and 13 as including the newly cited limitation of "a battery at least partly disposed within the case, the battery being electrically connected to the first laser diode". Applicant discusses that Imbrie does not dispose the battery within the

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case but discloses the battery within the module housing, however in accordance with MPEP 2144.04 VI C, In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.); therefore rearrangement or positioning of the battery does not modify the operation of the laser level and is considered a mere design choice or preference.

Claims 6 and 11 do not recite a first laser diode only claim 13 does, further it is not clear and understood how the battery is partly disposed. The limitation requires of claim 13 for the first laser diode to be connected thereby implying the second laser diode is not connected to the battery.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 6-14,

It is not clear and understood how the battery is partly disposed, since the drawings show the battery disposed within the case.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6,10-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imbrie et al (US 5,400,514).

Regarding claims 6,11,

Imbrie et al illustrates in figure 1 a laser instrument having a base (12) [applicant's case] which includes a motor (92) [applicant's motor] see figure 3 and column 6 lines 21-25, a shaft (16) [applicant's rotating shaft] that rotates about axis A column 4 lines 20-22, which implies 360 degrees, and a pointer unit (140 [applicant's module] having a laser diode (50) see figure 2 and column 5 lines 1-4. Thereby, as illustrated the laser diode and the rotating shaft are not coincident and the laser diode provides a laser beam which forms a reference plane perpendicular to the rotating shaft column 4 lines 22-24.

Imbrie et al does not disclose the battery partly disposed within the case.

However in accordance with MPEP 2144.04 VI C, In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.).

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In the instant application it would have been obvious to rearrange the location of the battery because the location of the battery does not modify the operation of the laser level and is considered a mere design choice or preference.

Regarding claim 10,

Figure 7 illustrated a circuit diagram for driving the laser diode, which includes a DC voltage source [applicant's battery].

Regarding claim 12,

As illustrated in figure 1 and described in column 4 lines 11-24, the laser diode is rotated about axis A of the shaft (16).

Regarding claim 13,

Imbrie et al illustrates in figure 1 a laser instrument having a base (12) [applicant's case] which includes a motor (92) [applicant's motor] see figure 3 and column 6 lines 21-25, a shaft (16) [applicant's rotating shaft] that rotates about axis A column 4 lines 20-22, which implies 360 degrees, and a pointer unit (140 [applicant's module] having a laser diode (50) see figure 2 and column 5 lines 1-4. Thereby, as illustrated the the laser diode and the rotating shaft are not coincident and the laser diode provides a laser beam which forms a reference plane perpendicular to the rotating shaft column 4 lines 22-24.

Imbrie et al does not disclose the use of a second laser diode.

However, in accordance with *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. In the instant case

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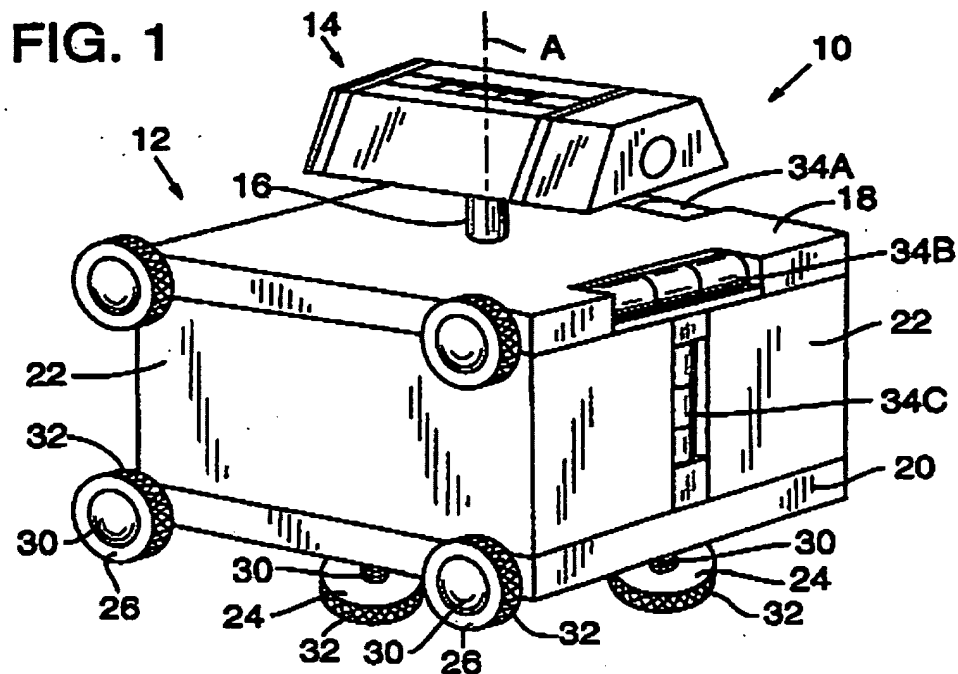
Imbrie has disclosed the recited limitations except for a second laser diode, which along with the recited first laser diode provide the reference plane. Imbrie et al does disclose a laser light source, which also forms a reference plane, therefore absent any new or unexpected result the recited second laser diode is considered a mere duplication of parts since the second laser diode only forms a reference plane. See MPEP 2144.04 VI.

Imbrie et al does not disclose the battery partly disposed within the case.

However in accordance with MPEP 2144.04 VI C, In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.).

Regarding claim 14,

Shaft (16) [applicant's rotating shaft] rotates about axis A, see column 4 lines 20-22, which implies 360 degrees.



Allowable Subject Matter

Claims 7-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: None of the cited prior arts alone or in combination discloses the claimed laser level having the recited limitations of dependent claims 7-9, in particular the module defines a hole which contains the laser diode.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

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See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ARMANDO RODRIGUEZ whose telephone number is 571-272-1952. The examiner can normally be reached on 9:00 AM - 5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MINSUN HARVEY can be reached on 571-272-1835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ARMANDO RODRIGUEZ
Examiner
Art Unit 2828



MINSUN HARVEY
SUPERVISOR
Art Unit 2828

AR/MH